

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Fitzpatrick et al.

Art Unit 3688

Serial No. 10/675,916

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For PLATFORM SYSTEM AND METHOD FOR EXTENDING SALES AND USE OF
A RESOURCE OF MOTIVATIONAL PROGRAMS

Examiner Raquel Alvarez

March 1, 2010

REPLY TO EXAMINER'S ANSWER

In the Examiner's answer, the Examiner asserts essentially the same points as in the final Office action. The Examiner's principal point of confusion, as addressed in Appellant's brief, relates to the "host" computer. Contrary to the Examiner's assertions, the "host" computer in Eggleston does not operate multiple customers' incentive programs, as recited by the claims. Instead, Eggleston's host computer acts as a purchase point for customers to purchase incentive programs, which are then downloaded to the customer's site for installation. The host computer in Eggleston thereafter allows the customer to list (not operate) the purchased incentive program in a listing of incentive programs. A participant may then locate an incentive program via a webpage on the host computer that displays the listing of incentive programs. Upon selecting a desired incentive program from the listing, the participant is directed away from the host computer to the customer's site where the incentive program is installed and operated. This explanation of Eggleston and the Examiner's misunderstanding was addressed in the brief at pages 9–10 and 17–22.

Appellants submit that the Examiner continues to add unsupported conclusory assertions to Eggleston. For example, on page 5 of the Examiner's Answer, in response to the Appellant's arguments, the Examiner states:

Figure 21 and col. 46, lines 41-50 teaches that if the fulfillment is to be done by the third party (**host**) then the information is mailed at step 676 to the third party for fulfillment of the award programs. In Eggleston, the incentive program is downloaded from the host (**third party**) maintains the incentive program on it's

own website (**centralized**) and participants have access to the incentive program through the sponsors. (Emphasis added).

As demonstrated by the quoted text above, the Examiner adds parenthetical statements to broaden the elements of Eggleston in order to conclude that Eggleston discloses every element of the claims. For example, the Examiner speculates that a "third party" is also a "host" in Eggleston, citing Figure 21 and col. 46, lines 41-50. Eggleston, however, clearly states the contrary:

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Referring to FIG. 21, a flow chart 660 depicts the flow of information among the components of the present invention. The consumer database 200 permits a query at a step 662 to determine whether a consumer has won a prize. The consumer database accesses the winner's file at a step 664 and identifies the fulfillment method associated with the winner at a step 668. Next, at steps 670, 672 and 674, the **host system** creates a file of the information obtained in the query for a **retailer, a sponsor, or a third party**. If the fulfillment is to be by a **third party**, the information is mailed at a step 676 to the third party for fulfillment. If the sponsoring firm is to fulfill the prize, the file is mailed at a step 678 to the sponsor. Otherwise, the retail database 204 is parsed by retailer at a step 680 and the file is transferred to the appropriate retailer at a step 682. The retailer verifies that the cardholder is the winner of the prize at a step 684, and the consumer collects the prize at a step 686. At a step 688, the retailer completes a report. At a step 690, the retailer creates a file of information regarding prizes fulfilled. At a step 692, the retailer uploads the file and supplies it to the incentive firm. At a step 694 the incentive firm verifies the information and pays the retailer. (Emphasis added).

In other words, the host system and third party in Eggleston are different, as the host system creates a file and, in the case of third party fulfillment, the file is mailed to the third party. In fact, the Examiner's conclusory statement that the "third party" is the "host" would lead to a nonsensical result in Eggleston, where the host system would create a file and then the file would be mailed to itself. As such, the portions of Eggleston cited by the Examiner do not support the Examiner's assertions.

Furthermore, the Examiner's assertions contradict themselves. The Examiner asserts, as quoted above, that "the incentive program [which] is downloaded from the host (third party) maintains the incentive program on it's [sic] own website (centralized) and participants have access to the incentive program through the sponsors". The

Examiner appears to admit that each incentive program is downloaded from the host and maintained on its own website, implying each program is maintained in a decentralized manner away from the host and not "centralized" as speculated by the Examiner.

Appellants submit that the Examiner uses impermissible hindsight garnered from claims 1 and 25 to read into Eggleston interfaces that permit the consolidation of participant accounts. According to the Examiner, "[i]n Eggleston, the participant accounts are consolidated because in Eggleston, there are various incentive programs 1-N that are run by the host(third party), the customer (participant) having one account # (812) to access the various incentive programs 1-N (see Figure 17) that she might be enrolled in." (Examiner's Answer, page 6). The Examiner admits that a customer/participant has **only one account number** for their account that is used to access the incentive programs. Using one account number to access multiple programs does not mean that the programs are consolidated. The Supreme Court cautions that a "factfinder should be aware, of course, of the distortion caused by **hindsight bias** and must be cautious of arguments reliant upon *ex post* reasoning". (KSR Int'l. Co. v. Teleflex Inc., 55 U.S. 398, 421 (2007)(citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, at 36, 86 S.Ct. 684 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (C.A.6 1964))).

In view of the above, independent claims 1 and 25 and their dependent claims are patentable over Eggleston.

CONCLUSION

For the reasons stated above, Appellant respectfully requests that the Office's rejections be reversed and that claims 1, 3–25 and 27–47 be allowed.

Respectfully submitted,

/Frank R. Agovino/

Frank R. Agovino, Reg. No. 27,416
SENNIGER POWERS LLP
100 North Broadway, 17th Floor
St. Louis, Missouri 63102
(314) 231-5400